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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/700,714

11/03/2003

Lanny R. Smith

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EXAMINER

FETSUGA, ROBERT M

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,714

Applicant(s)

SMITH, LANNY R.

Examiner

Robert M. Fetsuga

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/03/03 & 07/05/05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input checked="" type="checkbox"/> Other: <u>Fig. 5 of drawings</u>.</p> |
|---|---|

1. The proposed drawing correction filed on May 15, 2006 is disapproved as Fig. 5 thereof is not based upon the immediate prior version. A copy of the immediate prior version of Fig. 5 is attached hereto for applicant's convenience.

2. The drawings are objected to because reference numeral "57" (par. 0017 ln. 5) is missing from Fig. 3, reference numerals "66" and "68" (par. 0018 lns. 4 and 6) are missing from Fig. 4A, reference numeral "87" (par. 0020 ln. 2) is missing from Fig. 4B, and reference numeral "107" (par. 0021 ln. 2) is missing from Fig. 4C. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page

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header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis for the "removable coupling" set forth in claim 1 could not be found in the specification. Applicant is reminded claim terminology in mechanical cases should appear in the descriptive portion of the specification by reference to the drawing(s).

Applicant argues at page 15 of the response filed May 15, 2006 paragraph 0021 was amended "to specifically provide antecedent basis for the claimed terms 'removable coupling' and 'removable mating' as recited in claims 1 and 11, respectively." While the examiner agrees concerning the language of claim 11 (apparently tailoring the claim to the embodiment of Fig. 4C), the term "removable coupling" was not found in the noted paragraph.

4. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for

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an edge constructing apparatus clamped to a form member and wedged to a track, does not reasonably provide enablement for only a form mating portion and track mating portion. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Claim 11 is included here to the extent applicant's arguments directed thereto at page 16 of the response are commensurate with the similar arguments advanced for claim 1.

5. Claims 1, 11, 21, 22, 24-33 and 39-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is unclear as to whether the "swimming pool" is intended to be part of the claimed combination since structure of the "apparatus" is defined as being connected thereto (last line), but no positive structural antecedent basis therefor has been defined. Claim 11 is similarly indefinite. Applicant's argument(s) at pages 16-17 of the response does not address the issue of whether or not the swimming pool is intended to be subject matter excluded from the public by the claims.

Claim 11 is unclear as to the language "adapted to removably mate to the elongated track" and "adapted to removably

mate to the form member" (lns. 6-7). This subject matter is understood from the instant disclosure to be elements 50, 60 and 62. However, elements 50, 60 and 62 are recited in claims 12, 15, 17 and 37. Therefore, the metes and bounds of the language of claim 11 is not ascertainable. Applicant's argument(s) at page 16 of the response only addresses what are not adaptations of the support member.

Claims 21 and 22 are non-sequitur as being tailored to the embodiments of Figs. 4A and 4B where base claim 11 is tailored to the embodiment of Fig. 4C as argued at page 15 of the response.

Claim 24 is unclear as to whether the "swimming pool" is intended to be part of the claimed combination since structure of the "edging" is defined as being connected thereto (lns. 4 and 7), but no positive structural antecedent basis therefor has been defined. Claim 31 is similarly indefinite. Applicant's argument(s) at page 17 of the response does not address the issue of whether or not the swimming pool is intended to be subject matter excluded from the public by the claims.

Claim 24 is ambiguous as attempting to embrace two different statutory classes of invention. The claim preamble recites a "method", but the body thereof merely recites product/apparatus limitations in support of patentability. See

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IPXL Holdings LLC v. Amazon.com Inc. 77 USPQ2d 1140. Claim 31 is similarly indefinite. Applicant argues at page 18 of the response claims 24 and 31 recite two method steps of "removably coupling". The examiner agrees, however, these steps appear to be representative of known subject matter as indicated by the "black box" depictions in Figs. 6A and 6B.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-33, 35, 36, 38, 40, 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Loftin.

Considering claims 1, 11, 24 and 31 as drawn to the edging constructing apparatus per se, the Loftin reference discloses an apparatus comprising: a form member 24,48 including an edge

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forming surface 54, a support member mating portion (at 50) and an alignment member 70; a support member 46 including a form member mating portion (at 50) and a "track" mating portion (at 52); and a coupling member 50, as claimed. Re claim 1, the Loftin form member is "reusable" (i.e. able to be reused). Re claims 1 and 24, the Loftin apparatus is capable of being used with a swimming pool track in the functionally recited manner. Re claims 21-23, the Loftin form member produces the recited shapes (Fig. 8).

Applicant's argument(s) at pages 18-19 of the response does not address the issue of Loftin anticipating the claimed subject matter when the claims are considered drawn to the apparatus per se.

8. Claims 1-33, 35, 36, 38, 40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loftin and Stegmeier '424.

Considering claims 1, 11, 24 and 31 as drawn to the combination of a swimming pool and edging constructing apparatus, although the form member of the Loftin edging constructing apparatus does not include a cover track and associated mating portion, attention is directed to the Stegmeier '424 ('424) reference (Fig. 3) which discloses an analogous edging constructing apparatus which further includes a

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form member 28 having a cover track 44 and associated mating portion 34,46. Therefore, in consideration of '424, it would have been obvious to one of ordinary skill in the edging constructing apparatus art to associate a cover track and mating portion with the Loftin form member in order to enable retaining a pool cover.

Applicant's arguments with respect to claims 1, 11, 24 and 31 at pages 20-22 of the response have been considered but are moot in view of the new ground(s) of rejection.

9. Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art and Loftin.

Applicant discloses as admitted prior art (apa) an edging constructing apparatus (and swimming pool), as claimed, except for the form member being two separate portions removably coupled by a clamp. Attention is directed to the Loftin reference which discloses an analogous apparatus which further includes a form member 26,44 having two separate portions 24,48 and 46 removably coupled by a clamp 50. Therefore, in consideration of Loftin, it would have been obvious to one of ordinary skill in the edging constructing apparatus art to associate two separate portions removably coupled by a clamp with the apa form member in order to enable adjustment.

Applicant argues at pages 22-23 of the response the clamp 50 in Loftin does not removably couple a support member with a form member. While the examiner does not necessarily disagree, none of the argued claims recite such subject matter either.

10. Applicant's remarks have been fully considered and have been previously addressed.

11. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

12. The grounds of rejection have been reconsidered in light of applicant's arguments, but are still deemed to be proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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13. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

A handwritten signature in black ink, appearing to read "Robert M. Fetsuga", with a stylized flourish at the end.

Robert M. Fetsuga
Primary Examiner
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Replacement Sheet

